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7590

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EXAMINER

SOTOMAYOR, JOHN

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,367

Applicant(s)

YANAI ET AL.

Examiner

John L Sotomayor

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and newly added claims 26-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the amendment filed March 20, 2003, claims 1-25 and the newly added claims 26-32 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,4,5,8,17-19,26-29,31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mengoli (US 6,514,081).
4. Regarding claim 1, 31 and 32, Mengoli discloses a system and method of instruction for a sport that displays a plurality of basic examples of problem points and a particular problem point as clicked on by a user (Fig 3 and 4), providing an electronic means for recording, editing and searching one improved performance image of an instructor corresponding to the clicked problem point and displaying the improved performance image of an instructor (Col 4, lines 27-58), the display containing at least one method for overcoming the clicked problem and presented in a diagrammatic representation (Col 6, lines 35-67) wherein the clicked problem

Art Unit: 3714

point is a concrete problem of the learner in the sport (Col 5, lines 30-48) as shown by reference cues superimposed on the diagrammatic display.

5. Regarding claim 4, Mengoli discloses a system and method of instruction for a sport utilizing a computer system for recording, editing, processing through operations and searching the data of examples of individual problem points and means of improvement (Col 3, lines 40-62).

6. Regarding claims 5 and 8, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

7. Regarding claim 17, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the clicked problem point and the improved performance image of an instructor are still images or moving images (Col 6, lines 28-32).

8. Regarding claim 18, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the performance image of the clicked problem point, the improved performance image of an instructor (Col 6, lines 20-50) and an improvement method for overcoming the clicked problem point are recorded on a recording medium (Col 8, lines 41-67).

9. Regarding claim 19, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the sport is golf.

10. Regarding claims 26-29, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the performance image is the most closely approximate image to the concrete problem of the learner stored in memory (claim 26), preparing and displaying

Art Unit: 3714

several examples of performance problems of the learner (claim 27), the step of taking a performance image of the learner corresponding to the clicked problem point (claim 28) and wherein the concrete problem of the learner is determined by the learner (claim 29) (columns 5 and 6).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mengoli. Mengoli discloses a method of instruction for a sport improvement activity wherein the sport is a team sport including baseball, soccer or basketball (claim 20), wherein the sport is a combative sport including sumo, wrestling, judo or boxing (claim 21), wherein the sport is an outdoor sport including surfing, skiing, skating or swimming (claim 22), wherein the sport involves pursuing an object including fishing or hunting (claim 23), an instructional method wherein the hobby is

Art Unit: 3714

go, chess, shogi, dance or billiards (claim 24) or wherein the instructional method is medical treatment, a beauty treatment, weight training, flower arrangement, floral art or cooking (claim 25). Mengoli discloses an instructional method that is appropriate for activities such as baseball, tennis, dance and any other activity which includes a mechanical movement (Col 3, lines 27-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a method of instruction in a plurality of sports or activities such as baseball, wrestling, surfing, fishing or games such as billiards, flower arrangement or an activity such as cooking to provide the best example for a learner to emulate.

14. Claims 3, 7, 9, 11-13, 15, 16 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mengoli in view of Macri et al (US 6,183,259).

15. Regarding claim 3, Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein the system uses the Internet. However, Macri et al teaches utilizing the Internet as means of recording, editing, processing through operations and searching the data for methods for improvement as recorded on images (Col 3, lines 16-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the Internet as means of recording, editing, processing through operations and searching the data for methods for improvement as recorded on images for the purposes of expanding the use of the system to a wider base of users.

16. Regarding claim 7, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

Art Unit: 3714

17. Regarding claim 9, 11-13 and 15-16, Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein the performance images corresponding to the clicked problem points of an instructor are display without overlap. However, Macri et al teaches that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display methods for improvement to the user in images on a single screen without overlap for the purposes of a side-by-side comparison of the user against the instructor to assist the user in visualizing the motion needed for correction.

18. Regarding claim 30, Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein a question form is displayed and entries are analyzed so as to determine the concrete problem of the user. However, Macri teaches that a user may receive cues of a textual nature in assisting the correction of a concrete problem of a user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention that if a textual cue may be disseminated for correction, textual cues may also be received from a user to assist in determining the concrete problem of the user. Combining the system disclosed by Mengoli with the teaching of Macri produces a system that allows a broader means for the collection and dissemination of problem information and solution in a sports or other mechanical activity.

19. Claims 2, 6, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macri et al in view of Studor et al (US 6,152,856).

Art Unit: 3714

20. Regarding claim 2, Mengoli does not specifically disclose, nor does Macri et al teach using a DVD as the electronic means for recording, editing and processing through operations on video images selected. However, Studor et al teaches that a DVD system may be used to store and display higher quality video images (Col 6, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize a DVD for recording, editing, processing through operations and searching data for methods of improvement as recorded on images. Combining the system described by Mengoli and Macri et al with the teaching of Studor et al would provide a higher quality and longer lasting record for use in improving the skill of the user.

21. Regarding claim 6, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

22. Regarding claims 10 and 14, Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein the performance images corresponding to the clicked problem points of an instructor are display without overlap. However, Macri et al teaches that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to display methods for improvement to the user in images on a single screen without overlap for the purposes of a side-by-side comparison of the user against the instructor to assist the user in visualizing the motion needed for correction.

Art Unit: 3714

Response to Arguments

Applicant's arguments with respect to claims 1-25 and the newly added claims 26-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3714

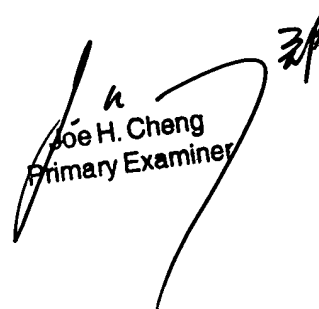
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Sotomayor whose telephone number is 703-305-4558.

The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-8361 for regular communications and 703-746-8361 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4558.

jls
August 8, 2003


Joe H. Cheng
Primary Examiner